

Remarks/Arguments

1. The specification is amended to correctly recite that the filter is identified by reference numeral 300 in the drawings. Withdrawal of the objection is respectfully requested.
2. Claims 1-10 are rejected under 35 USC §112, paragraph 1, for not providing the reasoning for using a filter that is transparent to infrared light in the specification. The Examiner cites *In re Mayhew* that refers to a case where a §112 rejection was upheld when a claim omitted matter disclosed to be essential to the invention as described in the specification. See, *In re Mayhew*, 527 F.2d 1229 (CCPA 1976).

The Examiner has taken this case out of context. There is no support for the Examiner's contention in *In re Mayhew* for requiring the applicant to provide reasoning for using a filter. Furthermore, there is no matter omitted in the claims that was disclosed to be essential in the specification. The applicant has clearly set forth in the specification and drawings how to make and use the invention to satisfy the statutory requirement of enablement.

Reasoning for using a claimed element does not enter into the enablement inquiry. A §112 rejection for lack of enablement is not proper if the applicant does not set forth the reason why certain elements are used, but does set forth how to make and use the invention. It is well settled that it is not a requirement of patentability that the inventor correctly set forth, or even know how or why the invention works, it is however a requirement that the applicant teach how to achieve the claimed result, even if the theory of operation is not correctly explained or even understood. See, *Newman v. Quigg*, 877 F.2d 1575, 1581 (Fed. Cir. 1989).

The applicant has set forth in the specification and drawings how to achieve the

claimed result of the invention. Furthermore drawings alone may be sufficient to satisfy the statutory requirement. See, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991).

Applicant respectfully requests withdrawal of the rejection.

3. Claims 1,3, 5-8 are rejected under 35 U.S.C. §103 as being unpatentable over Ishikawa[226] in view of Kaplan [043]. The Examiner states that Ishikawa discloses the claimed invention except for the filter being opaque to visible light and transparent to infrared light. The Examiner further states Kaplan discloses the use of such a filter.

The Applicant's invention is directed at a compact elliptical infrared light unit for a motor vehicle. The front face or lens of these types of infrared light units have a large surface area which is a disadvantage. The applicant's invention mitigates this disadvantage by having a reduced front surface area with a movable infrared filter. Claim 1 has been amended to further clarify the invention.

Ishikawa does not appreciate the problem solved by the applicant. This reference is directed to a head lamp having projection shades (212, 213, 222) used to adjust the light beam distribution pattern. The beam distribution pattern in this reference is altered in different directions. This reference does not teach or suggest the applicant's claimed invention.

Kaplan teaches a method and system for detecting marine obstacles. Kaplan in fact teaches away from what the applicant claims by using a filter that requires U.V. light frequencies. See, column 6, lines 20-43. The applicant, on the other hand, claims that the filter is only transparent to infrared, for use in infrared light units.

Since the references do not teach or suggest what the applicant claims withdrawal of the rejection is respectfully requested.

4. Claims 1-10 are rejected as being unpatentable over Eichler [147] in view of Kaplan[043]. The applicant repeats the same arguments previously submitted concerning

Kaplan. Eichler discloses a vehicle protection type headlamp with a movable shade device to reduce the maximum illumination intensity value. Eichler is silent as to reducing the front lens surface area of an elliptical infrared light unit having a movable infrared filter.

Since neither references teach or suggest what the applicant claims, withdrawal of the rejection is respectfully requested.


The applicant believes this application is in form for allowance and respectfully request such allowance. If the Examiner feels that an interview would expedite such an allowance, the Examiner may contact the below-mentioned attorney to schedule such an interview.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1948-4752. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

Respectfully submitted,
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Dated: AUGUST 7, 2003

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